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EXAMINER
JERVEY, S

ART UNIT 126

PAPER NUMBER

DATE MAILED: 03/28/90

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1-11 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-11 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☑ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☑ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "process", without the article "a" or "the" is vague and indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless-
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one (1) year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dominianni et al.

Claim 1 reads on the process described by Dominianni et al. (Dominianni) in columns 2 and 3, viz. the reaction of a receptor compound (2,6-dimethoxyphenol) with an adamantyl tertiary carbonium ion formed in situ in a cycloaliphatic type solvent as a result of the presence of sulfuric acid at ambient temperature.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth

in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 2-11 are rejected under 35 U.S.C. 103 as being unpatentable over Dominianni.

These claims all recite variations of Dominianni's process which would have been obvious to one skilled in the art at the time of the invention.

Changes in temperature, concentrations, or other process conditions of an old process do not impart patentability unless the recited ranges are critical, i.e., they produce a new and unexpected result. In re Aller et al, (CCPA 1955) 220 F2d 454, 105 USPQ 233.

Also, see In re Larsen (CCPA 1961) 292 F2d 531, 130

USPQ 209, for the holding that the mere use of different starting materials, whether novel or known, in a conventional process to produce the product one would expect therefrom does not render the process unobvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jervey whose telephone number is (703) 557-3920.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 557-3920.

03/16/90;rbb

PAUL J. KILLOS
PRIMARY EXAMINER
ART UNIT 126